

REMARKS

In the non-final Office Action, the Examiner made the prior restriction requirement final; withdrew claims 23-53 from further consideration due to the restriction requirement; rejected claims 1-8, 10-13, 15-22, and 54-59 under 35 U.S.C. § 103(a) as unpatentable over Awadallah et al. (U.S. Patent Application Publication No. 2005/0027699) in view of Microsoft Corporation ("Find and Return to Web Pages You've Recently Visited," dated March 26, 2003) (hereinafter "Microsoft"); and rejected claims 9 and 14 under 35 U.S.C. § 103(a) as unpatentable over Awadallah et al. in view of Microsoft and Milic-Frayling et al. (U.S. Patent No. 6,968,332) (hereinafter "Milic").

By this Amendment, Applicants amend claims 6, 18, and 58 to improve form. Claims 1-59 remain pending, of which claims 23-53 have been withdrawn from consideration by the Examiner. Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103.

REJECTION UNDER 35 U.S.C. § 103 BASED ON AWADALLAH ET AL. AND MICROSOFT

In paragraph 8 of the Office Action, the Examiner rejected claims 1-8, 10-13, 15-22, and 54-59 under 35 U.S.C. § 103(a) as allegedly unpatentable over Awadallah et al. in view of Microsoft. Applicants respectfully traverse the rejection.

Independent claim 1, for example, is directed to a method for providing search results. The method comprises receiving a search query; receiving first search results based at least in part on a search performed using the search query; performing a search of a history database using the search query to obtain second search results, the history database storing information regarding prior document accesses; modifying the first search results based at least in part on the second search results; and outputting the modified first search results.

Neither Awadallah et al. nor Microsoft, whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 1. For example, Awadallah et al. and Microsoft do not disclose or suggest modifying first search results, received based at least in part on a search performed using a search query, based at least in part on second search results, obtained by performing a search of a history database using the search query.

The Examiner alleged that Awadallah et al. discloses modifying first search results based at least in part on second search results and cited paragraph 0065 of Awadallah et al. for support (Office Action, page 7). Applicants respectfully submit that the Examiner's allegation lacks merit.

At paragraph 0065, Awadallah et al. discloses:

Another embodiment may involve calculating the C-level, Q-level, another level, commercial value and/or any other value of interest for all combinations of numbers of listings from different sources (or other allocation of other resources to usages by different sources) and comparing the results, especially if the number of different combinations of numbers of listings of interest are relatively few and/or the necessary calculations may be performed fast enough so that the user does not notice or does not get significantly annoyed. In an embodiment, a number of values of the function of interest may be calculated in order to bracket or approximately bracket the optimum value within a certain range of combinations of numbers of the different type of listings. Once the optimum combination has been bracketed, combinations within the range may be tried in order to further bracket the optimum combination of listings until an optimum combination is found. Alternatively, trial and error-like techniques or a myriad of other techniques may be used. The optimum value found of the C-level or any other level may be one of a range of values within a set tolerance. The optimum value found for the C-level or any other level may be one that is most optimal for a set possible composite search results being considered (e.g., combinations of listings or other resources or search results selected from search result candidates). The set of possible composite search results being considered may be a subset of possible composite search results for which a plurality of expected attributes were calculated. The subset may include those possible composite search results that satisfy certain conditions, such as an expected attribute value being below or being above a certain threshold.

In this section, Awadallah et al. discloses determining the combination of listings selected from search result candidates to include in the composite search results. Nowhere in this section, or

elsewhere, does Awadallah et al. disclose or remotely suggest second search results obtained by performing a search of a history database using the search query, as required by claim 1. In fact, Awadallah et al. discloses nothing remotely equivalent to a history database that stores information regarding prior document accesses. Thus, contrary to the Examiner's allegation, Awadallah et al. cannot disclose or suggest modifying first search results, received based at least in part on a search performed using a search query, based at least in part on second search results, obtained by performing a search of a history database using the search query, as required by claim 1.

Further, the portion of the above-identified section relied upon by the Examiner (namely lines 20-28) does not appear in the provisional application (60/492,018) upon which the Examiner relies for a date (August 1, 2003) prior to Applicants' filing date (September 30, 2003). Therefore, the Examiner's reliance on this portion is improper.

The Examiner alleged that Awadallah et al. discloses a history database storing information regarding prior document accesses and cited paragraphs 0039 and 0051 of Awadallah et al. for support (Office Action, page 6). Applicants respectfully disagree.

At paragraph 0039, Awadallah et al. discloses:

Other databases 118a-o is a collection of several databases, which may include a mixture of academic links, sponsored results and/or other data, and may include websites of individuals and non-profit organizations, and/or databases of Universities and other public databases, for example. Other databases 118a-o may include commercial websites of companies such as Amazon.com, Barnes & Noble, and Invitations on Line. There may be any number of databases in each of other databases 118a-o. Each of the other databases 118a-o may include their own servers and/or search engines. Some of the databases of other databases 118a-o may be accessible only via primary search engine 106, secondary search engine 108, and/or other search engine 110. Any combination of databases 118a-o may be connected, directly and/or via network 104, to one another.

In this section, Awadallah et al. discloses databases that can include a mixture of academic links, sponsored results and/or other data, and may include web sites of individuals, non-profit organizations, and Universities, and commercial web sites. Nowhere in this section, or elsewhere, does Awadallah et al. disclose or suggest that any of these databases is a history database that stores information regarding prior document accesses, as required by claim 1. Thus, nowhere in this section, or elsewhere, does Awadallah et al. disclose or suggest second search results obtained by performing a search of a history database using the search query, as required by claim 1.

At paragraph 0051, Awadallah et al. discloses:

The Q-metric may be calculated on a word-by-word and/or term-by-term basis. Each word and/or term may have its own Q-metric, and an overall or composite Q-metric for a search may be obtained by calculating a function (e.g., a sum) of the individual Q-metrics. Alternatively, some or all search terms may be grouped into categories, and each category may be assigned a Q-metric. There may be any number of categories. For example, in an embodiment there may be just one category for all possible search terms. In an embodiment, the Q-metric may be calculated over a sampling or over a total of all search terms for a given time period. In an embodiment the Q-metric may be different depending upon the purchasing history, previous search history, and/or residence of the searcher entering the search, for example.

Awadallah et al. discloses a Q-metric ("quality metric") that is used as a measure of expected customer satisfaction with a set of search results (paragraph 0010). In the above-identified section, Awadallah et al. discloses that the Q-metric can be calculated for each word/term in the search query and may be different depending on the purchasing history, previous search history, and/or residence of the searcher entering the search query. Applicants respectfully submit that it is unreasonable to allege that the information regarding purchasing history, previous search history, and/or residence of a searcher can be equated to a history database that stores information regarding prior document accesses because Awadallah et al. does not disclose or

remotely suggest performing a search of this information using a search query to obtain second search results, as required by claim 1.

Nevertheless, even assuming, for the sake of argument, that the information regarding purchasing history, previous search history, and/or residence of the searcher can be equated to a history database that stores information regarding prior document accesses (a point that Applicants do not concede for at least the reasons given above), nowhere in the above-identified section, or elsewhere, does Awadallah et al. disclose or remotely suggest performing a search of this information using a search query to obtain second search results, as required by claim 1.

The Examiner also alleged that Awadallah et al. discloses obtaining second search results and cited paragraph 0041 of Awadallah et al. for support (Office Action, page 6). Applicants disagree.

At paragraph 0041, Awadallah et al. discloses:

Query 152 is the query sent from user 102 to primary search engine 106. Composite search results 154 are the search results returned by primary search engine 106 as an answer to query 152. Candidate search results 155, 156, 158, and 160 are search results provided by candidate sources including database of primary search engine 112, secondary search engine 108, other search engine 110, and other databases 118a-o, respectively. Any combination of candidate search results 155, 156, 158, and 160 may represent a multiplicity of search result candidates from a corresponding multiplicity of candidate sources. Primary search engine 106 determines an amount of search results from candidate search results 155, 156, 158, and 160 to provide to user 102, and returns a composite of different and/or equal amounts of candidate search results 155, 156, 158, and 160 as composite search results 154.

In this section, Awadallah et al. discloses that primary search engine 106 obtains candidate search results and returns at least some of these candidate search results as composite search results to the user. Nowhere in this section, or elsewhere, does Awadallah et al. disclose or remotely suggest that any of the searched databases corresponds to a history database that stores information regarding prior document accesses, as required by claim 1. The Examiner alleged

that the information regarding purchasing history, previous search history, and/or residence of the searcher is allegedly equivalent to a history database that stores information regarding prior document accesses (Office Action, page 6). With this interpretation in mind, nowhere in the above-identified section, or elsewhere, does Awadallah et al. disclose or remotely suggest performing a search on the information regarding purchasing history, previous search history, and/or residence of the searcher to obtain second search results, as required by claim 1.

Further, the above-identified section relied upon by the Examiner does not appear in the provisional application (60/492,018) upon which the Examiner relies for a date (August 1, 2003) prior to Applicants' filing date (September 30, 2003). Therefore, the Examiner's reliance on this portion is improper.

The Examiner further alleged that Microsoft discloses performing a search of a history database using a search query to obtain second search results (Office Action, page 6). Even assuming, for the sake of argument, that the Examiner's allegation regarding the disclosure of Microsoft is accurate (a point that Applicants do not concede), Applicants submit that the mere fact that one reference allegedly provides some missing disclosure with respect to a claim does not satisfy the requirements of 35 U.S.C. § 103 as to why it would have been obvious to combine the references. Applicants respectfully assert that it would not have been obvious to combine the Microsoft disclosure with the Awadallah et al. system without using impermissible hindsight reasoning.

The Examiner alleged that it would have been obvious to one of ordinary skill in the art to incorporate Microsoft's teachings into the system of Awadallah et al. because it would allow users to find and/or return to interesting web pages that they visited today or a few weeks ago

(Office Action, page 6). Awadallah et al. is arguably directed to searching a plurality of databases based on a user's search query and returning results from these searches to the user (para. 0018). Microsoft is arguably directed to maintaining a history of web pages visited by a user and permitting the user to keyword search these web pages (pages 1 and 4). The only motivation for combining these two references is gleaned solely from Applicants' disclosure, which cannot be relied upon in establishing obviousness under 35 U.S.C. § 103.

For at least these reasons, Applicants submit that claim 1 is patentable over Awadallah et al. and Microsoft, whether taken alone or in any reasonable combination. Claims 2-8, 10-13, and 15-19 depend from claim 1 and are, therefore, patentable over Awadallah et al. and Microsoft for at least the reasons given with regard to claim 1.

Independent claims 20-22 and 56 recite features similar to, yet possibly different in scope from, features recited in claim 1. Claims 20-22 and 56 are, therefore, patentable over Awadallah et al. and Microsoft, whether taken alone or in any reasonable combination, for at least reasons similar to reasons given with regard to claim 1. Claims 57-59 depend from claim 56 and are, therefore, patentable over Awadallah et al. and Microsoft for at least the reasons given with regard to claim 56.

Independent claim 54 is directed to a method that comprises receiving a search query; searching a history database based at least in part on the search query to obtain search results, the history database storing information regarding previous document accesses; obtaining one or more advertisements relating to the search query; and presenting the search results and the one or more advertisements.

Neither Awadallah et al. nor Microsoft, whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 54. For example, Awadallah et al. and Microsoft do not disclose or suggest presenting search results, obtained by searching a history database based at least in part on a search query, and one or more advertisements relating to the search query.

The Examiner alleged that Awadallah et al. discloses search results obtained by searching a history database based at least in part on a search query and cited paragraph 0041 of Awadallah et al. for support (Office Action, page 14). Applicants respectfully disagree for at least reasons similar to reasons given with regard to claim 1. Further, as explained above with regard to claim 1, the provisional application (60/492,018) on which the Examiner relies for a date prior to Applicants' filing date does not include paragraph 0041 of Awadallah et al. and, therefore, cannot be relied upon by the Examiner.

The Examiner also alleged that Microsoft discloses search results obtained by searching a history database based at least in part on a search query (Office Action, page 14). Even assuming, for the sake of argument, that Microsoft discloses these search results (a point that Applicants do not concede), nowhere does Microsoft disclose or remotely suggest presenting the search results with one or more advertisements relating to the search query, as required by claim 54. Awadallah et al. discloses advertisements, but the Examiner has provided no motivation for combining the advertisements of Awadallah et al. with the search results of Microsoft. Therefore, the Examiner has not established a *prima facie* case of obviousness with regard to claim 54. Applicants submit that there is no motivation for combining the advertisements of Awadallah et al. with the search results of Microsoft absent impermissible hindsight reasoning.

For at least these reasons, Applicants submit that claim 54 is patentable over Awadallah et al. and Microsoft, whether taken alone or in any reasonable combination. Claim 55 depends from claim 54 and is, therefore, patentable over Awadallah et al. and Microsoft for at least the reasons given with regard to claim 54.

Accordingly, Applicants respectfully request the Examiner's reconsideration and withdrawal of the rejection of claims 1-8, 10-13, 15-22, and 54-59 under 35 U.S.C. § 103 based on Awadallah et al. and Microsoft.

*REJECTION UNDER 35 U.S.C. § 103 BASED ON
AWADALLAH ET AL., MICROSOFT, AND MILIC*

In paragraph 9 of the Office Action, the Examiner rejected claims 9 and 14 under 35 U.S.C. § 103(a) as allegedly unpatentable over Awadallah et al. in view of Microsoft and Milic. Applicants respectfully traverse the rejection.

Claims 9 and 14 depend from claim 1. The disclosure of Milic does not cure the deficiencies in the disclosures of Awadallah et al. and Microsoft identified above with regard to claim 1. Claims 9 and 14 are, therefore, patentable over Awadallah et al., Microsoft, and Milic, whether taken alone or in any reasonable combination, for at least the reasons given with regard to claim 1.

Accordingly, Applicants respectfully request the Examiner's reconsideration and withdrawal of the rejection of claims 9 and 14 under 35 U.S.C. § 103 based on Awadallah et al., Microsoft, and Milic.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request the Examiner's reconsideration of the application and the timely allowance of pending claims 1-22 and 54-59.

As Applicants' remarks with respect to the Examiner's rejections overcome the rejections, Applicants' silence as to certain assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or that such requirements have been met, and Applicants reserve the right to dispute these assertions/requirements in the future.

If the Examiner does not believe that all pending claims are now in condition for allowance, the Examiner is urged to contact the undersigned to expedite prosecution of this application.

PATENT
Application No. 10/673,681
Docket No. 0026-0039

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

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